

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOMOYUKI ASANO

Appeal 2006-3185
Application 08/865,403
Technology Center 3600

Decided: October 31, 2007

Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and JOSEPH A.
FISCHETTI, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Tomoyuki Asano (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 9, 17-25, 37-46, and 53-62, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

The Appellant's claimed invention is to a method and system for providing a service to a user and for enabling proper charge processing for the service (Specification 1). Claim 9, reproduced below, is representative of the subject matter on appeal.

9. A method for providing a service to a user, comprising the steps of:
 - receiving a service request requesting desired service for the user from a service provider and a digital signature generated based on said service request from a user terminal;
 - providing the service to the user terminal according to said service request;
 - requesting a charge collection from an accounting terminal based on said service request; and
 - providing said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received.

THE REJECTION

The Examiner relies upon the following evidence in the rejection:

Sirbu

US 5,809,144

Sep. 15, 1998

The following rejection is before us for review:

1. Claims 9, 17-25, 37-46, and 53-62 are rejected under 35 U.S.C. § 102(e) as anticipated by Sirbu.

ISSUE

The Appellant contends that Sirbu neither discloses nor suggests the step of providing a service request to the account server when a disclosure request is received (Appeal Br. 6). The Examiner found that Sirbu discloses this step of claim 9 (Final Office Action 3, citing Sirbu, col. 6, ll. 12-18 and Answer 4, citing Sirbu, col. 5, l. 44 – col. 6, l. 37). The issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 9, 17-25, 37-46, and 53-62 as anticipated by Sirbu. In particular, the issue before us is whether Sirbu discloses providing a service request and digital signature to an accounting terminal when a disclosure request of service requests and digital signatures is received.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Specification describes the claimed step of “providing said service request and said digital signature to said accounting terminal when a

disclosure request of service requests and digital signatures is received”
as follows:

Next, in a step S7, if the user 1 does not accept the amount of the fee, processing proceeds to a step S8 and for example, the user 1 informs the service provider 2 and the bank 3 that the user cannot accept the amount in a predetermined period and further, *the user 1 requests the service provider 2 to disclose the service request data and digital signature data already sent to the service provider 2.*

(Specification 6:11-17) (emphasis added.)

2. The customary definition of “request” as a noun is “1. The act of asking.
2. Something asked for.” The customary definition of “request” as a verb is “To express a desire for; ask for 2. To ask (a person) to do something.” *The American Heritage Dictionary of the English Language* (4th ed. 2000), found at <http://www.bartleby.com/61/93/R0169300.html>.
3. Sirbu does not teach that the step of sending the countersigned EPO is contingent on receipt of a disclosure request.
4. Rather, in Sirbu, once the merchant application software adds the merchant’s account number and other information to the EPO to create a countersigned EPO, the merchant application software automatically sends the countersigned EPO to the account server 16 (Sirbu, col. 6, ll. 12-18).
5. Although the countersigned EPO includes the EPO already received by the merchant from the user, the EPO sent from the user does not amount to a disclosure request, because Sirbu does not disclose that this EPO

contains an explicit or implicit request by the user to the merchant that asks the merchant to disclose the user's service request and digital signature to the account server.

6. As such, Sirbu does not anticipate claim 9 because it fails to disclose the step of "providing said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received."
7. Similarly, Sirbu does not anticipate claim 37 because Sirbu does not disclose any structure that performs the function of providing said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received.
8. Similarly, Sirbu does not anticipate claim 53 because Sirbu does not disclose that the service provider, i.e., the merchant, provides said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received.

PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

ANALYSIS

Independent claim 9 recites a method for providing a service to a user comprising the step of, *inter alia*, “providing said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received.”

The customary definition of request, as a noun, includes the act of asking (Finding of Fact 2). As such, we interpret the claimed “disclosure request” as the act of asking for disclosure of service requests and digital signatures. The example provided in the Specification, as reproduced *infra*, is consistent with this interpretation (Finding of Fact 1).

The Examiner relied on Sirbu’s disclosure of a merchant sending a countersigned Electronic Payment Order (EPO) to an account server as evidence of the claimed step of providing said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received (Final Office Action 3, citing Sirbu, col. 6, ll. 12-18 and Answer 4, citing Sirbu, col. 5, l. 44 – col. 6, l. 37). We disagree with this finding.

Sirbu does not disclose that the countersigned EPO is sent to the account server “when a disclosure request of service requests and digital signatures is received.” In particular, Sirbu does not teach that the step of sending the countersigned EPO is contingent on receipt of a disclosure request (Finding of Fact 3). Rather, in Sirbu, the merchant application software automatically sends the countersigned EPO to the account server 16 (Finding of Fact 4). Although the countersigned EPO includes the EPO already received by the merchant from the

user, the EPO sent from the user does not amount to a disclosure request, because Sirbu does not disclose that this EPO contains an explicit or implicit request by the user to the merchant that asks the merchant to disclose the user's service request and digital signature to the account server (Finding of Fact 5). As such, we find that Sirbu does not anticipate claim 9 because it fails to disclose the step of "providing said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received" (Finding of Fact 6). Accordingly, we cannot sustain the rejection of claim 9, or any of its dependent claims 17-25.

Independent claim 37 similarly recites a system for providing a service to a user comprising, *inter alia*, "means for providing said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received." For the same reasons provided *supra* for claim 9, we also cannot sustain the reject of claim 37, because Sirbu does not disclose any structure that performs the same function as recited in this element of claim 37 (Finding of Fact 7). We likewise cannot sustain the rejection of claims 38-46, which depend from claim 37.

Independent claim 53 similarly recites a system for providing a service to a user comprising, *inter alia*, a service provider that "provides said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received." For the same reasons provided *supra* for claim 9, we also cannot sustain the rejection of claim 53, because Sirbu does not disclose that the service provider, i.e., the merchant, performs the same

Appeal 2006-3185
Application 08/865,403

function as recited in this element of claim 53 (Finding of Fact 8). We likewise cannot sustain the rejection of claims 54-62, which depend from claim 53.

CONCLUSIONS OF LAW

We conclude that the Appellant has shown that the Examiner erred in rejecting claims 9, 17-25, 37-46, and 53-62 as anticipated by Sirbu.

DECISION

The decision of the Examiner to reject claims 9, 17-25, 37-46, and 53-62 is reversed.

REVERSED

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